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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,288	02/23/2004	Koshi Hatakeyama	1232-5303	2088
27123	7590	11/03/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			KIM, PETER B	
			ART UNIT	PAPER NUMBER
			2851	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/785,288	Applicant(s) HATAKEYAMA ET AL.	
	Examiner Peter B. Kim	Art Unit 2851	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 11-17, 29 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 18-28 and 31-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>112004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant elected Species I and claims “1, 3-10, 27, and 27.” However, it seems that claims 1-10, 18-28, and 31-34 read on the elected species.

This application contains claims 11-17, 29 and 30 drawn to nonelected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Objections

Claims 18, 26, 31-34 are objected to because of the following informalities: Regarding claims 18, 31, and 32, “an intermediate image is formed from second mirror to the fourth mirror” is unclear. Regarding claims 26, 33, and 34, “an intermediate image is formed from second mirror to the third mirror” is unclear. Instead of “from,” “between” seems more appropriate if applicant’s intention is to claim that the intermediate images is formed between the second and the third (or the fourth) mirror. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-25, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi (6,172,825).

Takahashi discloses a device fabricating method and an exposure apparatus comprising an illumination optical system (Fig. 2), a catoptric projection optical system comprising six mirrors including a first mirror which is a convex mirror (Fig. 4, col. 4, lines 60-64), wherein the intermediate image (IM) is formed between the third mirror and the fourth mirror on the optical path. Takahashi also discloses the system in order from object surface to the image surface, a second mirror, a first mirror, a fourth mirror, a sixth mirror, a third mirror, and a fifth mirror (Fig. 4).

Claims 1-10, 18-25, 27, 28, 31, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Mann et al. (Mann) (WIPO 02/056114).

Mann discloses a device fabricating method and an exposure apparatus comprising an illumination optical system a catoptric projection optical system comprising six mirrors (Fig. 1, page. 1, lines 9 and 10) including the first mirror which is a convex mirror (as admitted by applicant in written description page 5, lines 12-17) wherein the light incident upon the third mirror from the second mirror intersects with the light incident upon the fifth mirror from the fourth mirror (Fig. 1 of Mann and as admitted by applicant in written description page 5, lines 12-17). Mann also discloses intermediate image (IM) is formed between the third mirror and the fourth mirror on the optical path (Fig. 1).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10, 18-28, and 31-34 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,922,291 ("291") in view of Mann et al. (Mann).

Although the conflicting claims are not identical, they are not patentably distinct from each other because although 291 does not claim the first mirror which is a convex mirror, Mann discloses the first mirror which is a convex mirror. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the convex mirror of Mann as the first mirror in the claims of 291 in order to construct the optical system compactly.

Claims 1-10, 18-28, and 31-34 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of copending Application No. 10/783,788 ("788") in view of Mann et al.

Although the conflicting claims are not identical, they are not patentably distinct from each other because although 788 does not claim the first mirror which is a convex mirror, Mann discloses the first mirror which is a convex mirror. Therefore, it would have been obvious to one

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of ordinary skill in the art at the time of the invention to provide the convex mirror of Mann as the first mirror in the claims of 788 in order to construct the optical system compactly.

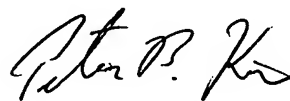
This is a provisional obviousness-type double patenting rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter B. Kim whose telephone number is (571) 272-2120. The examiner can normally be reached on 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Peter B. Kim
Primary Examiner
Art Unit 2851

October 29, 2005